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Paper No. 12

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In re Application of
Lowell S. Fink : DECISION DISMISSING
Application No. 09/781,167 : PETITION
Filed: February 13, 2001 :
Title: SEMI-ELLIPTICAL SAIL SYSTEM :
FOR WIND-PROPELLED VEHICLES

This is a decision on the petition under 37 CFR 1.137(a), filed May 14, 2003, to revive the above-identified application.

The petition under 37 CFR 1.137(a) is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled, "Renewed Petition under 37 CFR 1.137(a)."

The above-identified application became abandoned for failure to timely file a reply to the non-final Office action mailed September 13, 2002, which set a shortened statutory period of three (3) months for reply. Extensions of time under 37 CFR 1.136(a) were available. On December 4, 2002, applicant obtained a one month extension of time. However, no reply to the non-final Office action was filed within the one month extendable period. No further extensions of time with a reply having been filed, the above-identified application became abandoned on January 14, 2003. A Notice of Abandonment was mailed on April 22, 2003.

Petitioner maintains that the entire delay in filing the reply required from the due date of January 13, 2003 to the filing of the instant petition was unavoidable.

RELEVANT PATENT LAWS, RULES AND REGULATIONS

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by (1) the reply required to the outstanding Office action or notice, unless previously filed;

(2) the petition fee required by 37 CFR 1.17(l); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) as required pursuant to 37 CFR 1.137(d). The instant petition has not satisfied requirement (3).

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

> The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.[1]

Moreover, delay resulting from the lack of knowledge or improper application of the patent statutes, rules of practice or the Manual of Patent Examining Procedure, however, does not constitute "unavoidable" delay.[2]

ANALYSIS

Petitioner has not met his burden of establishing that the entire period of delay, from January 13, 2003 to the filing of the instant petition was unavoidable.

Petitioner argues, in essence, that he received erroneous oral advice from an employee of the Patent and Trademark Office. According to petitioner, he was instructed that he could obtain as much as a five month extension of time to respond to the non-final Office action of September 13, 2002. Therefore, petitioner was under the impression that he could have filed a reply to the Office action as late as May 13, 2003, with a five month extension of time. Petitioner states that he did not have "any reason" to question this advice.

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[1] In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

[2] See Haines, 673 F. Supp. at 317, 5 U.S.P.Q. 2d at 1132; Vincent v. Mossinghoff, 230 U.S.P.Q. 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 U.S.P.Q. 1091 (D.D.C. 1981); Potter v. Dann, 201 U.S.P.Q. 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).

First, petitioner is directed to 37 CFR 1.2, which states that "[t]he action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt." Accordingly, petitioner can not argue that he received erroneous oral advice to establish unavoidable delay. This is set forth in the Manual of Patent Examining Procedure, which states that "a delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice or the MPEP is not rendered 'unavoidable' due to the applicant's reliance upon oral advice from USPTO employees."[3]

In addition, petitioner is directed to the September 13, 2002 non-final Office action itself, which stated that the shortened statutory period for reply was set to expire three months from the mail date of the Office action. The Office action went on to instruct petitioner that "[i]n no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date".

Lastly, petitioner argues that the Office did not properly process his Change of Address, filed October 14, 2002, such that the Notice of Abandonment mailed April 22, 2003 was mailed to petitioner's old address. While petitioner is correct that the Office did not process the Change of Address, such oversight by the Office is immaterial to the delay at issue. The non-final Office action mailed September 13, 2002 **was** properly mailed to the address of record at that time. "Abandonment takes place by operation of law for failure to reply to an Office action..., not by operation of the mailing of a Notice of Abandonment."[4]

CONCLUSION

While the showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable, petitioner is not precluded from obtaining relief by filing a request for reconsideration pursuant to 37 CFR 1.137(b) on the basis of unintentional delay. A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the reply required to the outstanding Office action or notice, unless previously filed; (2) the petition fee set forth in 37 CFR 1.17(m)[5]; (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(d).

The Change of Address previously filed on October 14, 2002 was not entered, but has now been processed. Future correspondence concerning this application will be mailed to the new address as set forth above.

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[3] MPEP 711.03(c)(III)(C)(2).

[4] MPEP 711.03(c)(II).

[5] Currently $650 for a small entity.

Further correspondence with respect to this matter should be addressed as follows:

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Telephone inquiries specific to this decision may be directed to the undersigned at (703) 305-0272.

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